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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/474,783	12/30/1999	DONALD K. NEWELL	2207/6929	2707
7590	11/29/2005		EXAMINER	
John F Kacvinsky c/o Blakely Sokoloff Taylor & Zafman LLP 12400 Wilshire Boulevard Seventh floor Los Angeles, CA 90025				SHANG, ANNAN Q
		ART UNIT	PAPER NUMBER	2617

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/474,783	NEWELL ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Annan Q. Shang	2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 August 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,4-7,9 and 12-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,4-7,9 and 12-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4-7, 9 and 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Russo (5,619,247)** in view of **Horton et al (4,945,563)**.

With respect to Claim 1, **Russo** teaches a system for controlling use of broadcast content comprising a receiver in communications with a source of broadcast content and a playback device and a storage device, wherein the receiver is configured to extract the descriptor or supplemental information and control the use of the received broadcast content through the playback device and storage device in accordance with descriptor in the received broadcast content (fig.2, col.3 lines 3-28, lines 50-60, col.6 lines 12-25, col.8 lines 55-67). Russo teaches where a Storage Device (SD) 14 is coupled to Receiver (R) 4 (fig.1, col. 3 lines 3-20 and lines 40-64).

Furthermore, the authorization key and compression algorithms directly define actions or operations to be taken pertaining the broadcast data. Russo teaches that descriptor information indicates a length of time that the received broadcast content may be consumed (col.5 lines 32-46, viewer may be allowed to view the selected program as many times as desired over a particular time).

Russo further teaches that the descriptor or supplemental information may in the broadcast content path 102 (col.8 lines 65-67, col.9 line 1), but fails to explicitly state that this control information is embedded in the content and also defines the action to store the received broadcast content or reproduce the received broadcast content prior to viewing.

However, Horton teaches broadcasting audiovisual content along with embedded descriptor information to define an action to be taken pertaining to the received content, explicitly storing the received broadcast content (col.3 lines 38-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo with the ability to specify the action as storing the content and embedding descriptor information as in Horton in order for the broadcast provider to specify what could be done to the broadcast programs to prevent unauthorized copying and also allow the user to only access certain programs.

As to claim 4, Russo further teaches that the receiver is configured to maintain information relating to the use of the received broadcast content (col.3 lines 20-25, col.5 lines 48-65).

As to claim 5, Russo teaches that the receiver is configured to use the information relating to the use of the received broadcast content for remuneration of a provider of content (col.4 lines 45-67, col.5 lines 20-33, col.6 lines 34-55).

As to claim 6, Russo teaches that the information relating to the use of the received broadcast content comprises, a duration of use (col.5 lines 32-47).

As to claim 7, the claimed “method comprising...” is composed of the same structural elements that were discussed in the rejection of claim 1.

As to claim 9, Russo teaches lengths of time and days that the broadcast may be viewed (co1.5 lines 33-48), but fails to show that the descriptor information indicates the number of times the received broadcast content may be consumed. Limiting the number of times is a logical variation of the restriction of viewing already set forth by Russo and therefore would have been obvious to one of ordinary skill in the m at the time the invention was made. This would enable the broadcast facility to supply the viewer with various pricing and viewing options.

As to claim 12, Russo teaches that the video can be saved for a predetermined length of time but doesn't specifically state a date range (col. 5, lines 32-46). It is nonetheless inherent that this time period would be more then one day, thus covering a range of dates.

As to claim I3, it is inherent that the information sent to the user site would include billing information (col. 6 lines 10-27).

As to claim 14, it is inherent that the information sent to the user site would contain information for the cost of consuming the broadcast (col. 6 lines 10-27).

As to claim 15, Russo teaches the ability to “unlock” certain viewing options with a code sent along with the video stream (col. 6 lines 10-27). This inherently prevents the unjustified use of the broadcast material since other options would remain locked.

Regarding Claim 16, teaches shows obtaining payment information from the user (col. 6 lines 20-28, lines 35-46, col. 10 lines 10-48).

Regarding Claim 17, teaches shows communicating consumption information to a billing facility (col. .6 lines 34-53, col. 10 lines 10-48).

Regarding Claim 18, teaches shows that the billing facility comprises a facility maintained by a provider of the broadcast content (col. 6 lines 20-36).

As to claim 19, the claimed "a machine-readable medium... a method comprising..." is composed of the same structural elements that were discussed in the rejection of claim 1.

As to claim 20, Russo further teaches where the storage comprises a memory accessible by a computer.

As to claim 21, Russo fails to show that the storage medium comprises a portable storage device. Official Notice is taken that it is well known and expected in the art to use removable storage devices, such as CD-ROMS or removable hard drives.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Russo with a portable storage device so that the instructions could be transported to other systems.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1, 4-7, 9 and 12-21 have been considered but are moot in view of the new ground(s) of rejection.

With respect to amended independent claims 1; 7 and 19, Applicant argues that the prior arts of records **Russo (5,619,247)** and **Horton et al (4,945,563)**, fail to teach or suggest at least the feature, i.e., "the descriptor to indicate whether the storage

device may store the received broadcast content prior to viewing" of independent claims 1, 7 and 19. Applicant further argues that Russo also teaches away from the claimed descriptor and argues that the combination of Russo and Horton is improper and no motivation to combine Russo and Horton

In response, Examiner disagrees. Examiner notes applicant's arguments, however, Russo teaches sending the control data with the broadcast information (col.8 lines 65-col.9, line 1+, supplemental or control information, may be from program provider along path 102, using modulation/demodulation capabilities), but fails to explicitly state that the control information is embedded in the broadcast content. The Horton reference is used to show embedding control information into a broadcast stream (col. 3 lines 38-67, coded information embedded in the TV signal). Russo teaches sending control information to the user (col.6 lines 12-52, key sent with broadcast to allow decoding, col.7 lines 55-67, keys allowing decoding to only those selected subscribers). Furthermore, this control information is descriptive of the control information and the control functions, which are to be implemented by the data. The term "descriptor" is no more limiting or clarifying than the previously disclosed limitation of "control information." Additionally, Russo also teaches that this descriptor data indicates a length of time the playback device may reproduce the broadcast content (col. 5 lines 32-46, viewer may be allowed to view the selected program as many times as desired over a particular time). This meets the limitations of indicating a length of time the playback device may reproduce the content.

Russo, further fails to explicitly teach where the descriptor, indicates whether the storage device may store the received broadcast content prior to viewing. However, Horton teaches broadcasting audiovisual content along with embedded control information to define an action to be taken pertaining to the received content, explicitly storing the received broadcast content (col. 3 lines 38-67, 'coded information embedded in the TV signal,' 'indication...of various modes available with this particular program').

In response to Applicant's argument that there is no suggestion to combine the references, the examiner maintains that, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In this case Russo teaches using a descriptor, or control information, to indicate the length of time the playback device may reproduce the received content (col. 5 lines 32-46, viewer may be allowed to view the selected program as many times as desired over a particular time). Russo fails to explicitly state that this descriptor information is embedded in the broadcast content and can control the ability to record. However in the same field of endeavor, Horton teaches broadcasting audiovisual content along with embedded control information to define an action to be taken pertaining to the received content. Russo and Horton are in the same field of endeavor, i.e., a broadcast provider controlling unauthorized use or recording of broadcast media. Hence the 103(a) rejection of Russo in view of Horton, is proper and maintained, meets all the claimed

limitations and the appropriate motivation was given, i.e., prevent unauthorized copying and also allow the user to only access certain programs, as discussed above. The amendment to all the independent claims necessitated the new ground(s) of rejections using the same references. This office action is made final.

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tsukamoto et al (5,796,828) disclose controlled-access broadcast signal receiving system.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC)** at **866-217-9197 (toll-free)**.



Annan Q. Shang.



CHRIS KELLEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600